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09/02/2003

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EXAMINER
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LEVY, NEIL S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 09/02/2003

32

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Examiner

Applicant(s)

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 6/09/03
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-8, 12-18, 36-51 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-8, 12-18, 36-51 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8, 12-18, 36-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims require comparison to undefined "conventional", indefinite "fast-release" formulations of the array of triazole fungicide formulations that may or may not be encapsulated, coated, granules, polymer matrices, powders, suspensions, dispersions, applied to plants or to seeds. Absent specification of the ratio for the composition claims, and for methods, also the desired formulations and of those to be compared to, there is required an enormous amount of testing, of each crop, with each fungicide, with each formulation possibility, to determine which ratios achieve 50% with which polymer.

The factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described in *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988). Among these factors are: (1) the nature of the invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary. When the above factors are

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weighed, it is the examiner's position that instant disclosure fails to meet the enablement requirement for the following reasons:

(1) The nature of the invention: known compounds and formulations, at specific ratios compared to other known compounds and formulations, applied to plants.

(2) The state of the prior art known compounds formulations, with controlled release known, but requiring phytotoxicity testig for crops of concern.

(3) The relative skill of those in the art

The relative skill of the those in the art is high-agronomist.

(4) The predictability or unpredictability of the art

The unpredictability of the art is very high.

(5) The breadth of the claims

The claims are broad, as polymer, triazole specific combination and ratio are not claimed.

(8) The quantity of experimentation necessary extensive testing would be required.

Applicant's arguments filed 6/5/03 have been fully considered but they are not persuasive. Applicants' arguments have resulted in reconsideration.

Claims 1-3, 7, 8, 12, 15, 17, 18, 36, 39, 43-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoffmann et al 5914295.

The rejection of record is maintained. The now claimed particle size is met. (col.6, line 49) since the matrices of Hoffmann provide for controlled releas , and result in improved plant protection, over unreliable systems of conventional application (col.9,

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lines 17-28), they would inherently compare as do the instant compositions, with other formulations, and so provide the same phytotoxicity reduction. Note the instant claims are compositions, or methods using the compositions, met by Hoffmann; not testing methods.

Claims 1-8, 12-18, 36-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffmann et al 5914295 in view of admission of Known triazoles.

The rejection of record is maintained. The claimed triazoles are all known fungicides, thus, it would be obvious to one with ordinary skill in the art of crop protection, to utilize the triazole desired for protection of the crop of concern in any of the known formulations, as of Hoffmann.

The selection of ingredients are result effective parameters chosen to obtain the desired effects. It would be obvious to vary the concentration and form of each ingredient to optimize the effect desired, and the use of ingredients for the functionality for which they are known to be used is not a basis for patentability.

Claims 1-3, 5, 7, 8, 12-18, 36-39, 41, 43, 45, 46, 48, 50 are rejected under 35 U.S.C. 102(e) as being anticipated by Dao et al 5719103.

Powders of 100 micron (col.6, lines 45-55) are provided. See Table 1, example 1-up to 98% active, tebuconazole, exemplified, at a ratio to polymer of 14/32, the polymer a vinyl polymer, acrylic acid, with plasticizer, as a powder, with dispersant, diluent. This is the instant composition. The claimed comparison is not made with phytotoxicity, however, plant and seed are treated, so phytotoxicity is has to be a concern, but the ratio of active to polymer is shown as adjustable, to provide 0.1-90% of

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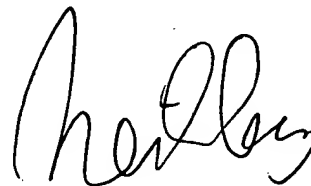
the powder as active. However, we give no patentable weight to the particle formulation claims as to how they might be compared to other formulations. Since the claimed compositions are those of Dao, inherently Dao has the same characteristics; if compared, the same results must follow. The instant methods, applying the formulations to plants (foliar) or seeds (col.2, lines 54-63) as liquid aqueous suspensions and dispersions since granule/powder size are not instantly identified-we see no difference here packaging to provide wettable powder is at lines 63-68, col.2. thiadimenol is @ col.18, line 24.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is 308-2412. The examiner can normally be reached on Tuesday- Friday 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1235.

Levy/tgd  
August 26, 2003



NEIL S. LEVY  
PRIMARY EXAMINER